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dneels@bnpatentlaw.com
dmasters@bnpatentlaw.com
mnickerson@bnpatentlaw.com



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/705,657
Filing Date: November 10, 2003
Appellant(s): THALER ET AL.

Jeremy Thaler et al.
For Appellant

**SUPPLEMENTAL
EXAMINER'S ANSWER**

This is in response to the appeal brief filed 11-26-08 appealing from the Office action mailed 8-22-08.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

NEW GROUND(S) OF REJECTION

Claims 9, 11, 19 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lui in view of Hinds et al. (UNHYDROGENATED PALM OIL as a Stabilizer for Peanut Butter) and Harris et al. (2,560,509) as applied to claims 1, 10, 12-18, 20, 22-23, and further in view of Krisinski et al. (4,143,176).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2560509	HARRIS et al.	7-1951
4,143,176	KRINSINSKI et al.	3-1979
6,982,101	LIU et al.	1-2006

Hinds, et al. "Unhydrogenated Palm Oil as a Stabilizer for Peanut Butter",
Journal of Food Science, vol. 59, no. 4, 1994, pages 816-820.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

DETAILED ACTION

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Appellant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 10, 12-18, 20, 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu et al. (6,982,101) in view of Hinds et al. (UNHYDROGENATED PALM OIL as a Stabilizer for Peanut Butter) and Harris et al. (2,560,509).

Liu discloses a peanut butter spread as in claims 1, 12 and 15 having ground peanuts added in amounts from 60-80% and oil in the amounts of 1-15%. The reference discloses the use of "at least one stabilizer in a total amount up to about 4 wt %". "Up to" reads on zero.

Liu discloses a sweetened nut butter spread made by grinding nuts in the presence of oil at a temperature of from ambient to 165 F (abstract and col. 2, lines 50-70). Cooling is a given since peanut butter is not kept in a heated state. The palm oil is used in amounts from 1-15%, preferably 2-12% (col. 3, lines 5-10, 20-25). A nut paste is disclosed which contains at least 9% peanuts (col. 2, lines 1-70). Claims 1, 12, 15 differ from the reference in the use of organically grown peanuts and organic palm oil. Nothing new is seen in using organically grown peanuts as opposed to commercially grown peanuts, absent a showing of unexpected results in using peanuts which are grown without the use of chemical fertilizers. Claim 12 further requires that no free oil on the surface and storage for 60 days. However, as the composition has been shown, it seen that no oil is on the surface and the storage is as claimed. Therefore, it would have been obvious to use known organically grown peanuts and to make a product is has no free oil on the surface of the peanut butter for 60 days.

Claims 1, 12 and 15 have been amended to require that the oil is palm stearin oil. However, Liu et al. disclose the use of palm oil and Hinds et al. disclose that it is known to use an unhydrogenated palm oil as a stabilizer for peanut butter (abstract), and that the fatty acid composition of palm oil is 4.-5.5% stearic (page 816, col. 1, 3rd, para.). Harris et al. disclose that it is known to make peanut butter with sugar and polyglycerols

melted at from 55-80 C (col. 1, lines 44-55, col. 2, lines 1-1-34). The polyglycerol can be of the stearic acid monoester of a polyglycerol variety. The reference discloses that higher molecular weight fatty acids can be used in small amounts in nut butters (col. 3, lines 22-48). As it is disclosed that the stearic acid is helpful in keeping oil from separating, it would have been within the skill of the ordinary worker to choose natural oils containing stearic acid, with little routine experimentation, to find a natural oil, which contains stearic acid. Harris et al. also, discloses the use of monostearin and distearin (col. 1, lines 25-30. In addition, as shown by appellants' specification, on page 4, 3rd paragraph, Organic palm Stearin (POS) is a known ingredient and "that other alternative organic palm oil products made by Spectrum and other suppliers may be substituted as equivalents". Appellants can use palm oil and the specification does not limit the claims to palm oil stearin. No criticality has been shown in the use of palm oil stearin. Therefore, it would have been obvious to use unhydrogenated palm oil which contains stearic acid (stearin) since as a higher long chain fatty acid, it is more solid at room temperatures than other oils.

Nothing new is seen in adding the oil during the grinding step into the mill, as in claim 13 as this has to have been done in order for the peanuts to have been ground (abstract). Liu discloses grinding nuts in the presence of oil to make a nut paste (col. 1, lines 50-55). However, Harris discloses that it is known to combine a high stearin ingredient with nut butter at from 50-80 C (col. 1, lines 44-55, col. 2, lines 1-3, col. 3, lines 25-41). Nothing has been shown as to the product being any difference if the stearin oil is adding only in the mixing phase as in claim 12. If it were added during

grinding, it would still be in the mixture in the combining phase. Therefore, it would have been obvious to dispense oil into the apparatus during grinding of the nuts or in the combining step as shown by the reference as no criticality is seen in either method.

Claims 14 and 15 further require preheating the oil before dispensing the oil into the mill at particular temperatures and claim 16 requires roasting the peanuts before grinding. The reference is silent as to heating the oil. However, nothing new is seen in heating the oil before adding it since the peanut paste and oil were maintained at a temperature above 133 F. absent a showing of unexpected results using the claimed temperatures. Certainly the nuts are roasted before grinding (col. 2, lines 41-50). Therefore, it would have been obvious to dispense oil into a mill at particular temperatures and to grind the nuts prior to roasting.

Liu discloses roasting nuts at from 270 to 370 as in claim 17 (col. 2, lines 41-50). Therefore, it would have been obvious to roast at known temperatures.

Removing the skins is disclosed in col. 2, lines 44-50 as in claim 18.

Nothing new is seen as in claim 20 of collecting and pumping the peanut mixture to a heat exchanger and filling station, which is routinely done in the art. Therefore, it would have been obvious to collect, and pump the mixture in order to put it into containers.

Adding salt and sweetener is disclosed in col. 5, lines 40-60, as in claims 22 and 23, and milling to within the claimed range is disclosed in Lui who uses from 10-20 mils, preferably 13 mils.

Claims 1, 3-8, 10, 12-18, 20, 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hinds.

Hinds et al. disclose as in claim 1 that it is known to make a composition containing ground peanuts stabilized with palm oil. In addition, as shown by appellants' specification, on page 4, 3rd paragraph, Organic palm Stearin is a known ingredient and "that other alternative organic palm oil products made by Spectrum and other suppliers may be substituted as equivalents". Appellants can use palm oil and the specification does not limit the claims to palm oil stearin. The use of only "palm stearin oil is not seen as critical since the specification does not say it is critical. In addition, as shown by appellants' specification, on page 4, 3rd paragraph, organic palm Stearin (POS) is a known ingredient and "that other alternative organic palm oil products made by Spectrum and other suppliers may be substituted as equivalents". No criticality has been shown in the use of palm oil stearin. Mixtures of palm oil in amounts of 2-4% and ground peanuts were tested, so it is seen that 90% ground peanuts were used (page 817, col. 1, para. 1-3). The amount of fat in the peanut butter (PB) would have been less than 55% since the peanuts contain only 49%, (page 1, col. 1, para. 4, line 5). Claim 1 differs from the reference in the use of organically grown peanuts, in the amount of oil, and in whether there would be free oil on the surface of the peanut butter. However, no difference is seen in the use of organically grown peanuts and those grown with fertilizers at this time. Whether the peanuts are grown with organic fertilizers or chemicals, chemicals are also found in organic fertilizers as everything is made up of chemicals or chemical compounds. The reference discloses that in using amounts of 2-

4% oil, no free oil is seen on the surface of the PB up to 29 C. (page 815, page 1, para. 1, under Results and Discussion and col. 2, top graph). The claim requires from "about 5% oil" since it is not known what the range of 'about 5%" encompasses. Also, no patentable distinction is seen at this time between the use of 4% oil and 5% oil. As it is well known that the amount of oil in a peanut butter product affects its taste, it would have been obvious to add a little more oil for its known function. Therefore, it would have been obvious to use more oil in a PB composition for its known function. The melting point of palm oil is disclosed to be 36-40 C. as in claim 3 (page 816, col. 1, 2nd para. of Hinds et al.). No patentable distinction is seen in 4 degrees, as the melting point is influenced by the amount of saturated fat, which might vary from product to product. Also, Appellants' particular POS has been disclosed as a known product in the specification. Therefore, it would have been obvious to substitute the POS of a known product with its more precisely fractionated stearin portion for the POS of Hinds.

Claim 4 further requires heating the palm oil before it is blended with the peanuts. However, this is a method limitation in a composition claim. Nothing is seen that the palm oil is not at the melting point since it is referred to as an oil. Therefore, it would have been obvious to use the palm oil in the form of an oil as disclosed by the reference.

Claims 5 and 6 require particular amounts of salt and sweetener from zero amounts up. The reference used 4.71% sugar and .79% salt (page 817, col. 2, para. 1.).

Claim 7 further requires unrefined organic cane sugar, and claim 8 requires particular types of well-known sweeteners. No patentable distinction is seen in the use of well-known sweeteners or in the use of organic sweeteners. Of course, aspartame, saccharine and cyclamate, are not organic sweeteners as they are man made. Therefore, it would have been obvious to use known sweeteners for their known function.

Claim 8 further requires the use of the germ of the peanut. Nothing is seen that the germ has been removed from the peanut as in Hinds et al. It is well known that the germ can be used or not used. Therefore, it would have been obvious to use the germ or not use the germ in the claimed composition.

Claim 10 further requires Valencia peanuts and claim 11 a particular particle size. The reference uses Florunner seed (page 817, last. Para.). It would have been within the skill of the ordinary worker to use particular types of peanuts, since the varieties used are well known as are their characteristics. The reference discloses that the mixture was finely ground (0.13 mm clearance between stones) (page 817, 1st para.). It is not seen that this is different than that claimed at this time. Nothing is seen that oil would have been seen on the surface of the peanut butter after 60 days. Therefore, it would have been obvious to use known peanuts and to grind to a particular degree absent unexpected results.

Claim 12 is to the method of grinding the peanuts in a mill and claim 13 that the oil is dispensed into the throat of the mill. The further limitations have been disclosed above and are obvious for those reasons. Hinds et al. disclose grinding peanuts in a

vertical mill and adding the other ingredients (page 817, para. 1.). Nothing new is seen in adding oil at the most convenient place in the apparatus since adding oil later would require another mixing step. Therefore, it would have been obvious to grind as disclosed.

Claims 14 and 15 further require preheating the oil before dispensing the oil into the mill at particular temperatures and claim 16 requires roasting the peanuts before grinding. The reference is silent as to heating the oil. However, nothing new is seen in heating the oil before adding it since the peanut paste and oil were maintained at a temperature above 133 F. absent a showing of unexpected results using the claimed temperatures. Certainly the nuts are roasted before grinding (col. 2, lines 41-50). Therefore, it would have been obvious to dispense oil into a mill at particular temperatures and to grind the nuts prior to roasting.

Roasting peanuts is well known as in claim 17, and it would have been obvious to roast at known temperatures to achieve a desired flavor.

The peanuts are blanched as in claim 18 (page 817, para. 1).

Nothing new is seen as in claim 20 of collecting and pumping the peanut mixture to a heat exchanger and filling station, which is routinely done in the art. Therefore, it would have been obvious to collect, and pump the mixture in order to put it into containers.

Adding salt and sweetener is disclosed as above as in claims 22 and 23.

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: Claims 1, 10, 12-18, 20, 22-23 are

rejected under 35 U.S.C. 103(a) as being unpatentable over Liu et al. (6,982,101) in view of Hinds et al. (UNHYDROGENATED PALM OIL as a Stabilizer for Peanut Butter) and Harris et al. (2,560,509).

NEW GROUND(S) OF REJECTION

Claims 9, 11, 19 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lui in view of Hinds et al. (UNHYDROGENATED PALM OIL as a Stabilizer for Peanut Butter) and Harris et al. (2,560,509) as applied to claims 1, 10, 12-18, 20, 22-23, and further in view of Krisinski et al. (4,143,176).

Krisinski et al. disclose that it is known to use particle sizes of from 8-20 microns as in claims 11 and 24 (col. 1, lines 58-70). Also, Krisinski et al. disclose that it was known to make a conventional peanut butter using normal skins and germ in the amounts of 50-60% as in claims 9 and 19 (col. 2, lines 22-41). Therefore, it would have been obvious to grind the nuts to a particle size as claimed as shown by Krisinski et al. in the process of the combined references, and to add the skins and germ to the composition.

ARGUMENTS

Appellant's arguments filed 11-26-08 have been fully considered but they are not persuasive.

Appellants argue that Liu teaches away from the present invention as it is to nut butter spreads, that peanut oil is the preferred edible oil, and that a sweetening composition is used, which contains a stabilizer such as hydrogenated vegetable oil to prevent oil separation. However, the claims are open comprising type claims, and no

ingredients have been excluded from the claims. If one removed the additional ingredients such as sugar, one would have a peanut butter instead of a peanut butter spread. The same problem exists of oil separation in both products.

Appellants argue as to the use of "at least one stabilizer in a total amount up to about 4 wt.%", that it does not teach "no stabilizer". However, the patent and the claims have different embodiments of the invention. In the specification, there are at least two embodiments, one without a stabilizer and one with, and the same as in the claims (col. 1, lines 45-70, col. 2, lines 1-25). In the patented claims, claims 10-14 do not require a stabilizer, nor do claims 50-52. The term "preferably" does not mean that a stabilizer is required. Nothing has been shown that the composition of Liu would separate without the use of a stabilizer, especially with the use of palm oil which Liu states would prevent oil separation (abstract). Liu et al. does teach the use of diglycerides and stearin oil contains diglycerides (col. 7, lines 56-60). The reference to Hinds then teaches that it is known to use 5-7% organic, non-hydrogenated palm stearin oil.

Appellants argue that Liu does not teach particular amounts of the non-hydrogenated organic palm stearin oil. However, the reference discloses from 2-15% oil, which can be palm oil, which is known to contain stearin (col. 3, lines 5-10, lines 20-25). It would have been within the skill of the ordinary worker to use particular amounts of oil to make a suitable composition as only a limited amount of testing is required to determine what amount makes the most stable product. Certainly, the problem of oil on the surface of peanut butter is notoriously old, hence any ground peanut butter with no

additives has oil on the surface, and the inventors in the Liu patent would have been aware of this problem, and would have adjusted their ingredients accordingly. Routine experimentation can be used as in the KSR decision, in it being obvious to try, i. e. choosing from a finite number of identified, predictable solutions. In this case, only so much of the POS or palm oil would be necessary to stabilize peanut butter. Also, the result is predictable, as POS is known to stabilize as disclosed by Lui et al. in view of Baileys (KSR, 119 Fed Appx 282, 288 (Fed.Cir.2005)).

Appellants argue that there is no basis for combining the references. However, Lui et al. disclose the use of palm oil in peanut butter spread, Hinds et al. specifically discloses the use of palm oil in peanut butter, Appellants' specification, shows no criticality in the use of POS, and actually says that palm oil is used in the composition, Harris et al. disclose monostearin, distearin and stearic acid as above. Appellants argue that the limitation of combining ingredients with ground peanuts in a mill with oil has not been shown. Liu discloses grinding nuts in the presence of oil to make a nut paste (col. 1, lines 50-55). Harris et al. disclose that it is known to combine a high stearin ingredient with nut butter at from 50-80 C (col. 1, lines 44-55, col. 2, lines 1-3, col. 3, lines 25-41). Nothing has been shown as to the product being any different if the stearin oil is adding only in the mixing phase. If it were added during grinding, it would still be in the mixture in the combining phase. Appellants argue that Harris is used to conclude that stearic acid could be used as found in unhydrogenated palm oil. However, Harris discloses that it is known to use from 1% to about 5% of a stearic acid

partial ester of polyglycerol. This is not using appellants' claims as a guide, but a direct teaching of using stearic acid in peanut butter at within the claimed amounts.

Appellants argue that the rejection of Hinds and Harris as applied to claims 1, 3-8, 10, 12-18, 20, 22-23 is not proper since it does not include Liu and Baileys. However, Baileys has been dropped, and the rejection is over Hinds now. Albeit the claims listed were wrong, but one can see the rejection was over Hinds and could easily see what claims were included in the rejection of Hinds in view of Baileys..".

Appellants argue that Krisinski discloses teaches adding only 50-60% of the germ.. However, the claims do say "substantially", and the amount used is seen on reading on "substantially all" since it is more than half and the reference uses the phrase "a major portion" (col. 2, lines 23-25). In addition, nothing unobvious occurs from adding more of very small particles of germ, except that more of a nutritive material is added. It is not seen that the step of homogenization would teach away from adding all the peanut germ. If one wanted a lot of dark pieces in the peanut butter, then certainly more can be used without producing anything inventive.

As to claim 19, the reference states that peanut germ is removed after the blanching step (col. 1, lines 10-22). It is seen that, the germ being removed directly after, blanching, could be included in the blanching step. Since it is known that the germ must be made smaller, it would have been obvious to add it in the grinding step if one were not going to homogenize as in the reference to Krisinski et al.

Appellants argue as to homogenization in regard to claims 9 and 11. However, they are composition claims and homogenization is not required. Therefore, the loss of losing flavor volatiles is not given weight.

Appellants argue that the reference to Krisinski does not teach the claimed particle size. It is seen that the claimed 10 – 15 microns is found in the range of 8-20 microns (col. 1, lines 65-70). Micrometers are the same thing as microns.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Helen F. Pratt/

Primary Examiner, Art Unit 1794

12-31-09

Conferees:

/KEITH D. HENDRICKS/
Supervisory Patent Examiner, Art Unit 1794

/Gregory L Mills/

Supervisory Patent Examiner, Art Unit 1700

Art Unit: 1794

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Gregory L. Mills/

Supervisory Patent Examiner, Art Unit 1700

Technology Center's designee